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In re Application of
Enrique Monlina
Application No. 09/995,486
Filed: November 28, 2001

: DECISION ON PETITION
: Under 37 CFR 1.181
:
:

For: **BUILDING CONSTRUCTION SYSTEM**

This is a decision on applicant's Petition Under 37 CFR 1.181 to Vacate a Final Rejection as Premature, filed April 4, 2006.

The petition is **GRANTED**.

Applicant's petition raises many issues as to why the finality of the Final Rejection mailed January 26, 2006 should not have been made final.

Applicant argues that the amendments to the claims in the June 28, 2005 response did not raise any new issues. A review of that amendment indicates that substantial changes were made to independent claim 1. Several new limitations were added and almost half the limitations of the claim from its previous iteration were deleted. Applicant further argues that the newly cited reference to Hibbard is just as relevant to the claims as they appeared prior to the June 28, 2005 amendment and should have been applied in the previous action. That is not the criteria for improper finality. If the amendment requires further consideration or search as a result of amendment to the claims, regardless of the results of that further consideration or search, then final status is proper.

Applicant also argues that, in the Final Rejection, an objection to claim 5 was raised for the first time. This objection was not in response to any amendment made to that claim. However, new objections can properly be raised in a final rejection.

However, it is also argued that, in the amendment filed June 28, 2005, the dependency of claim 17 was changed from claim 9 to claim 48. Claim 9 had been in withdrawn status as being drawn to a non-elected invention. Claim 48 was a new claim and since the examiner examined claim 48 it can be considered as being drawn to the elected invention. Thus, claim 17 should have been examined at the time of the Final Rejection as indicated by applicant. Therefore the Final Rejection was incomplete:

In view of the fact that the final rejection was incomplete due to the failure to properly treat amended claim 17, the petition is **GRANTED**. The finality of the January 26, 2006 Office action is withdrawn.

Applicant, in this petition, brings up the fact that he requested reinstatement of claims 9-10, 14-16, 28-29 and 31-35 in the amendment filed March 21, 2006. However, this amendment was filed after the Final Rejection of January 26, 2006 and is not relevant to the finality of the January 26th Office action. It is noted that the examiner will need to address this request in her next Office action.

The application is returned to the examiner to respond to the amendment filed March 21, 2006 which is entered as a matter of right, the finality of the previous Office action having been withdrawn. In that response the examiner will indicate the finality of the previous Office action rejection is withdrawn.

For any questions concerning this decision, please contact Supervisory Patent Examiner Carl Friedman at 571-272-6842.


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CF/snm: 5/18/06